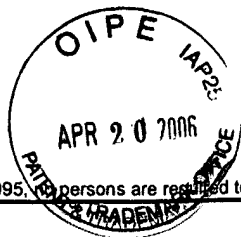


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

00630.0320-US-D1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on

Signature

Typed or printed name

Jennifer Armstrong

Application Number

10/657513

Filed

8 September 2003

First Named Inventor

Martin Reed Bodley

Art Unit

2642

Examiner

Jack Chiang

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

(See Notice of Appeal and Request for Pre-Appeal Review document)

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 29,555

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

Michael B. Lasky

Typed or printed name

952-253-4100

Telephone number

17 Apr 06

Date

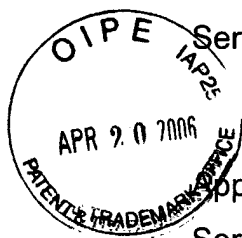
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒

\*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Serial No. 10/657513

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Martin Reed Bodley et al. Examiner: Jack Chiang  
Serial No.: 10/657513 Group Art Unit: 2642  
Filed: September 8, 2003 Docket No.: 00630.0320-US-D1  
Title: HEADSET COMMUNICATION UNIT

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450 on

17 April 2006

Jennifer Armstrong  
Name

Jennifer Armstrong  
Signature

**NOTICE OF APPEAL AND REQUEST FOR PRE APPEAL REVIEW**

Under Pre-Appeal Brief Conference Pilot Program

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the final rejection in the above identified application.

No amendments are being filed with this request.

**Basis for Pre-Appeal Conference**

Applicant requests review of the final rejection because of clear error in the last office action.

This application is based on USSN 09/813 103 which in turn has a foreign priority claim from Denmark under PA 2000 000 765, filed 9 May 2000, which information drawn from Private Pairs and can be verified as such. The primary reference cited in the final office action is Weinans, a PCT publication (Wo 01/37524) which was filed 7 November 2000 (after the filing date of the parent to the present application). It claims

two priorities, only one of which (60/164 877) can possibly be the basis for asserting the Weinans reference as prior art. This priority document is quite different from the PCT publication and consequently, the Weinans PCT document cannot be, as a matter of law, be asserted as prior art. This was brought to the attention of the examiner, but not considered or responded to. This is clear error.

In fact, the priority document 60/164 877 (a public record within the US Patent Office), states only that the changing of the function of the switches can be accomplished by a mechanical switch. See page 3 line 18 of 60/164 877.

The claimed invention, in claim 13 requires that the earhook switching from right to left usage causes the function switches to swap function. In Claim 17, the earhook has non-symmetrical portions which to actuate a switch and swap functions. Claim 25 specifically recites that the hinge has asymmetrical portions which allow for detection of right or left ear usage. Claim 26 calls for circuitry for detecting the changed operation (left right) in response to earhook orientation.

The examiner asserts the entire PCT document (Weinans) and then combines it with the Yang reference. Using, the examiner's own words, "Yang teaches providing a symmetrical/asymmetrical earhook (col4. lines 21-22)." The purpose of this assertion is to make the case that an asymmetrical earhook would provide a teaching of how to combine it with the Weinans, to achieve the present invention. *This is clear error and does not make out a prima facie case.* First, col. 4 lines 21-22 recite no such thing. They state only, "In addition, the shape and size of the ear braces 220a and 220b can be identical or somewhat dissimilar". This means the braces do not have to be exactly identical. But to what end? No purpose (read: teaching) is to be found in Yang as to

what to do with this dissimilarity. It is probably that Yang meant that manufacturing tolerances and accommodation for ear comfort are acceptable. Totally lacking is a teaching suggestion, or even a hint, of why one would use this dissimilarity to trigger a switch to reverse function switches in Weinans. (There are no function switches in Yang, so there is no basis for even an implied teaching.)

The USPTO's own MPEP rule 706.02(j) requires much more to assert a 35 U.S.C. sec 103 rejection:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. [Emphasis added]

The examiner has failed to state how Yang suggests how or why one would combine a "slightly different brace" with Weinans (it doesn't), or what a "slightly different brace" would be used for, or that it either references teaches or suggests all claim limitations as required by rule 706.02(j), (Yang and Weinans are each missing elements of the rejected claims).

The error in assessing the Yang reference and the use of the entire PCT document when only the first priority document can even be asserted as prior art, are two clear errors.

This case has been thoroughly searched and the examiner has applied art in several combinations, yet has been unable to make a true prima facie case of unpatentability, without clear error in applying the 35 U.S.C. sec 103 or MPEP rule 706.02(j).

It is therefore submitted that the final rejection be withdrawn and the case be now passed to allowance.

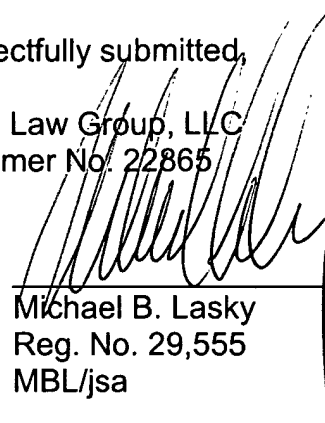
If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Applicant's attorney of record, Michael B. Lasky at (952) 253-4106.

Respectfully submitted,

Altera Law Group, LLC  
Customer No. 22865

Date: 17 April 2006

By:

  
\_\_\_\_\_  
Michael B. Lasky  
Reg. No. 29,555  
MBL/jsa